

REMARKS

Claims 1-43 are pending. By this Amendment, claims 1, 15, 30, and 42 are amended to clarify the moldable layer in response to the §112 rejection, discussed below. Support for the amended subject matter can be found, for instance, in the last sentence of paragraph [0050]. No new matter has been added. Reconsideration of the rejections is requested in view of the remarks below.

Obviousness-type Double Patenting Rejections

In the Office Action, claims 1-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

Claims 1-85 of copending application no. 10/821,202 (it is noted that this listing of claims is in error as only claims 1-78 and 80-82 are pending);

Claims 1-21 of copending application no. 11/023,412;

Claims 1-19 of copending application no. 11/023,413; and

Claims 1-20 of copending application no. 11/034,255.

The explanation for each rejection is virtually identical and merely states that both articles contain coverings for use on an exterior surface [sic: and] are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer. The rejections are improper in that they do not consider the specific limitations of each claim and do not present a prima facie case of obviousness, as required.

An analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). The following factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. §103 must also be employed when making an obvious-type double patenting analysis. These factual inquiries include:

- (A) determining the scope and content of a patent (or application) claim relative to a claim in the application at issue;
- (B) determining the differences between the scope and content of the patent (or application) claim as determined in (A) and the claim in the application at issue;
- (C) determining the level of ordinary skill in the pertinent art; and
- (D) evaluating any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

- (A) the differences between the inventions defined by the conflicting claims (i.e., a claim in the patent (or application) compared to a claim in the application); and
- (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

None of these determinations have been made in the Office Action, and in particular the differences between the claims have not been identified. The Office Action merely notes that the “comprising” language in the claims is open ended and that allows for other materials or layer to be present in the construction of the covering. This is not a full or proper analysis. Each of these applications is directed to different inventions and recites different claim features, which have not been acknowledged. It is the responsibility of the Patent Office to point to differences in each of the claims and then provide reasons why each claimed invention would have been an obvious variation of another. This deficiency in the rejection was pointed out in the last response and was not addressed, but the rejection is repeated. The rejections are improper and should be withdrawn.

#### Indefiniteness Rejection

Claims 1-43 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The phrase “moldable layer” in claims 1, 2, 5, 10, 12-19, 22, 27, 29, 30, 32-36, and 41-43 is deemed unclear. The Office Action states that it is unclear from the claim language and the

specification what is meant by moldable layer. The specification is quite clear in this regard and provides ample explanation with example compositions and numerous qualities of the layer, as evidenced below. Moreover, the meaning of the term *moldable* would be readily recognized by one of ordinary skill in the art of adhesives and has additionally been used in its conventional sense wherein to mold means *to shape or to fit closely*. The Examiner's attention is directed to the following instances explaining the moldable layer in the specification, which should answer each of the questions raised:

"The moldable material may be homogenous, such as a solid strip of pressure sensitive adhesive (PSA), or may be a composite. Preferably, the moldable layer is water impermeable, non-absorbent, substantially incompressible, and plastically deformable." (*See paragraph [0020].*)

"The moldable layer 34 is preferably made of a pressure sensitive adhesive (PSA) that is a hot melt, meaning it is applied to the fibrous layer 30 at 100% solids. Suitable adhesive compositions are available from many different manufacturers and can be used as a hot melt adhesive applied on the back surface 32...It is preferred that hydrophilic adhesives not be used, as such adhesives would inhibit drying of the strip 20 during exterior use." (*See paragraph [0048].*)

"Any type of moldable or malleable material application is suitable as layer 34 as long as it forms a strong, yet flexible integral structure providing a fibrous layer 30 with a moldable layer 34 directly bonded thereto and an outer surface having an adhesive quality. As noted above, the moldable layer 34 may be a single material, such as a PSA. The layer 34 may also be a composite layer formed of a malleable material, such as silicon caulking, green rubber or other flowable material, with an inherent adhesive quality or an adhesive layer applied to the outer surface. If the moldable material is not inherently adhesive, it may be desirable to apply the moldable layer 34 to the back surface 32 of the fibrous layer 30 by an adhesive or other secure attachment technique. The viscosity of the moldable material may also be varied to affect penetration. The moldable material may also function as a waterproof layer based on its composition and/or thickness. It is preferred that the material be free of foamed voids, either open cell or closed cell." (*See paragraph [0049].*)

"As the moldable layer 34 will become integrally attached to the surface that it covers, it is important to obtain 100% coverage of the bottom surface 36." (*See paragraph [0050].*)

"It is contemplated that with different molding materials, application techniques, and environments that different volumes or amounts could be successfully used as long as the material has the ability to mold to the irregular surface of the board to form a permanent bond." (*See paragraph [0051].*)

"The moldable layer 34, particularly the hot melt pressure-sensitive adhesive of the preferred embodiment, is selected to provide an initial high level of tack or aggression of adhesion so that the covering strip 20 initially securely bonds to the exposed surfaces 14 of the deck 10. The aggression of the adhesive is sufficient that it applies adhesive contact across substantially the full width of the exposed surface 14 of each board 12, but does not necessarily engage into individual cracks in the wood immediately upon contact. The initial attachment is therefore provided by the aggressive action of the adhesive surface of the moldable layer 34. The layer 34 creates a bond between the fibers of layer 30 and the exposed surface 14 of the deck 10." (*See paragraph [0064].*)

"In fact, over time, due to various factors, including freeze-thaw cycles, the entry of moisture and other contaminants in the strip 20, and general wear and tear, the adhesive effect of the adhesive surface of the moldable layer 34 can reduce. The thickness of the moldable layer 34 is therefore designed so that over time the material is molded by pressure of normal exterior use into the exposed surface 14 of the wood so that it engages into cracks and other distortions in the board 12 to provide a secondary adhesive effect caused by the molding action. Thus, even when the initial adhesive effect of the layer 34 has deteriorated or even disappeared, a mechanical interlock or adhesion remains due to the molding or flow of the moldable layer 34 into the discontinuities in the exposed surface 14. The moldable layer 34 thus mates with the surface 14 and provides a secure attachment in the long term between the fibers of layer 30 and the board 12. (*See paragraph [0065].*)

As the specification clearly explains the possible compositions and the desired qualities of the moldable layer in detail as shown above, it is submitted that the term is clear and definite and that one of ordinary skill in the art would readily understand what is meant by the claimed moldable layer. The rejection should be withdrawn. Claims 1-43 are definite.

#### Prior Art Rejections

Claims 1, 2, 5, 6, 15, 16, 22, 23, 30, 31, 32, 33, 35-37, and 41-43 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,554,194 to Haas et al. (Haas). This reference was cited in the Patent Search Statement accompanying the Petition to Make Special<sup>1</sup> filed with this application, but is newly applied in this office action. As a supplement to this response, the remarks previously submitted with respect to Haas distinguishing the claims are referenced herein as the Office Action lacks a response to these

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<sup>1</sup> It is noted that the Petition still has not been acknowledged by the Patent Office, despite having received two Office Actions and specifically raising its filing during the personal interview with the Examiner.

arguments. The Patent Search Statement fully describes Haas and points out specific differences with the claims.

In summary, Haas uses a thin layer of adhesive to allow for areas to become loosened after application. Haas' suggested applied volumes of adhesive range from 35-65 gsm. Haas does not have a layer that provides the molding effect that characterizes this invention. The Office Action seems to combine several different embodiments of Haas (despite the anticipation rejection), but confuses the intermediate layers with the adhesive layer. For instance, the Office Action points to both the foamed polyurethane layer described in col. 11, lines 37-38 and the bonding layer 2 as a moldable layer. However, Haas discloses a first embodiment in which layer 2 has an underside 21 with protuberances 23 that extend through layer 2, yet provides examples that use an additional adhesive layer that are provided in discrete spots, for example. One of the portions of the specification identified in the Office Action uses a bottom adhesive layer applied in an amount of 35 gsm. It is unclear how the Office Action is reading Haas onto the claims since the discussion jumps between embodiments and selects different elements to read on the same claim component.

In an effort to make a bona fide response to this rejection, it is asserted that Haas fails to disclose, in any embodiment, a moldable layer directly applied to the **entire** back surface of a fibrous layer and forming a **solid** bottom surface with an adhesive quality, as in claims 1, 15, and 42; a moldable layer with an adhesive surface applied directly to the back surface of an elongated strip of floor covering material and forming a **solid** adhesive layer that directly attaches the back surface to an upper surface of a board, as in claim 30; or, a hot melt adhesive moldable layer directly applied to the **entire** back surface of a fibrous layer, as in claim 43. Haas does not meet each and every feature of the claims and therefore cannot anticipate the claims. Claims 1, 15, 30, 42, and 43 and their dependent claims are allowable.

Claims 30-32, 36 and 41 are also rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,695,493 to Friedlander et al. (Friedlander). According to the Office Action, Friedlander discloses a composite strip comprising a layer of fibrous floor covering material, a mold layer formed of hot melt adhesive covering the entire back surface of the strip, with a thickness of 1-20 mil, and a release sheet on the attachment layer. This rejection is repeated from the first Office Action.

Applicant has explained Friedlander in detail in the last response and in the Patent Search Statement so no further explanation is required. In response to Applicant's arguments that Friedlander's carpet does not remain resilient or possess elasticity during application, the Office Action states that Friedlander teaches of a carpet that may be formed or reformed by hand into a stable shape and thus remains unchanged during the life of the article. This argument supports Applicant's distinctions. As is conventionally known, resilience is the property of a material that enables it to resume its original shape or position after being bent. Elasticity is the ability to return to an initial form after deformation. In Friedlander, after the carpet is bent or deformed it **retains** its shape. It does not resume its original shape or return to its initial form. Friedlander's carpet is not capable of being rolled while remaining resilient and does not possess elasticity during the application of the carpet to a board. In fact, Friedlander is specifically designed with a **shape retaining web** to prevent the carpet from remaining resilient and possessing elasticity. Thus, Friedlander does not meet each and every feature of claim 30 or its dependent claims 31, 32, 36, and 41. These claims are allowable.

Claims 3, 4, 17-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Haas in view of Friedlander. The Office Action states that Haas discloses the invention substantially as claimed but fails to disclose the moldable layer being between the claimed ranges. Friedlander is cited as teaching of a moldable layer formed of hot melt adhesive

having a thickness of 1-20 mil. The Office Action asserts that it would have been obvious to have provided the thickness of the moldable layer along with the release sheet in Haas in order to form a carpet that may be formed or reformed by hand into a stable shape as taught by Friedlander.

It seems that the Office Action is suggesting that providing a layer of adhesive having a thickness of 1-20 mil in Haas' carpet would cause Haas' carpet to be hold a stable shape. This is not understood. Nevertheless, merely increasing the thickness of adhesive in Haas' carpet would not meet the claim features, as noted above with respect to the anticipation rejection. Haas does not disclose or even suggest of a moldable layer directly applied to a fibrous layer that forms a solid bottom surface with an adhesive quality. Further, Haas' carpet is specifically designed to form a loose bond with the floor so increasing the thickness of adhesive would be counter to the object of the invention. Proper motivation to modify Haas has not been provided. Claims 3, 4, and 17-21 are not rendered obvious by Haas as proposed to be modified by Friedlander.

Claims 13, 14, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Haas in view of U.S. Patent No. 5,204,155 to Bell et al. (Bell).

Bell is added to teach of a moldable layer that is applied at a coating weight of between 185 and 600 gsm for the purpose of having a flooring that is sufficient to distribute compressive weight of objects placed on the face of the floor surface covering. It is asserted that it would have been obvious to provide such a moldable layer with such a coating weight in Haas to have a flooring that is sufficient to distribute the compressive weight of objects placed on the face of the flooring surface as taught by Bell.

As noted in the prior response, Bell discloses a foam backed carpet having a series of layers between the carpet layer 14 and the bottom surface. In particular, Bell's carpet tile is formed of fabric 12 having tufted face 14, a thin precoat layer 16 of rubber latex, a first layer

18 of bitumen containing glass fiber or scrim sheet material 20, a closed cell foam layer 22, a second bitumen layer 24 with tissue sheet material 26 therein, and a non-woven polyester or polypropylene backing layer 28. The layer directly applied to the back surface of the fibrous layer is the thin precoat layer 16. There is no moldable layer directly attached to the back surface of the fibrous layer with a release sheet attached thereto. In fact, there is no release sheet. (Col. 6, lines 6-27.) The bitumen layers are about 1300 g/m<sup>2</sup>. Thus, Bell also lacks the claimed moldable layer forming a solid bottom surface and being directly applied to the back of the fibrous layer with a release sheet thereon.

Bell is cited as allegedly teaching of using a moldable layer with a coating weight of greater than 185 gsm. However, Bell merely discloses using an intermediate bitumen layer in a foam backed carpet tile of 1300 g/m<sup>2</sup>. The object of Bell is to address issues of compressive force in foam backed carpeting. The Office Action asserts that to provide a layer with such thickness in Haas would have been obvious to distribute the compressive weight of objects placed on the face of the flooring. It is unclear how the addition of a thick bitumen layer in Haas would be an advantage or where such a suggestion would originate.

The combination of Haas and Bell lacks several features of the claims. Further, the combination is improper as there is no suggestion in the prior art for making the suggested modifications. It is noted that even if the suggested modifications could be properly made, all of the features of the claims would not be met by such a combination as explained above. Claims 13, 14, and 34 are allowable.

Claims 7, 8, 12, 24, 25, 29 and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Haas in view of U.S. Patent No. 6,426,129 to Kalwara et al. (Kalwara).

Kalwara is cited for teaching of a composite strip having a predetermined width less than 12 inches, a predetermined length at least 25 feet and a release sheet with free edges. It is asserted that it would have been obvious to have provided the claimed lengths and widths



in Haas' covering in order to have a release liner that is easy to disengage from the tacky surface of the adhesive layer as taught by Kalwara.

First, Haas does not disclose a moldable layer directly applied to the back surface of the fibrous layer and forming a solid bottom surface. Second, with respect to claims 7, 8, and 12 Haas does not disclose a moldable layer applied at a volume of at least 185 gsm. Kalwara does not remedy these deficiencies. So these features are not met by the asserted combination of prior art. Third, Kalwara is directed to an adhesive rubber article for use in the roofing industry. There is no suggestion in the prior art for why it would have been obvious for someone of ordinary skill in the floor covering art to look for roofing membranes for motivation to modify Haas' carpet panels. Absent proper motivation, a prima facie case of obviousness cannot be made. As such, claims 7, 8, 12, 24, 25, 29 and 40 are not rendered obvious over Haas in view of Kalwara and are patentable.

Claims 9-11, 26, 27, 28, 37<sup>2</sup>, 38 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Haas in view of U.S. Patent No. 3,937,640 to Tajima et al. (Tajima).

Tajima is cited for teaching of a composite strip having a release sheet with a central release sheet. The Office Action states that it would have been obvious to have provided various methods of applying a release sheet to the back surface of the covering of Haas in order to render application easier.

With respect to claims 9-11, Haas does not disclose the volume of at least 185 gsm. Tajima does not remedy these deficiencies. So these features are not met by the asserted combination of prior art. As for claims 11, 28, and 39, these recite that the central release strip **overlaps** the release strips on the edges, which is not shown by Tajima or addressed in the Office Action, despite having this deficiency pointed out in the last response.

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<sup>2</sup> It is noted that claim 37 is rejected as being anticipated by Haas and by being obvious over Haas as modified by Tajima. It is unclear why Haas would have to be modified by Tajima in order to meet the claim features if Haas' disclosure allegedly can anticipate the features of claim 37.

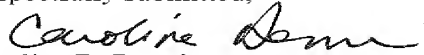
Finally, Tajima is directed to laminated bituminous roofing membranes. There is no suggestion in the prior art for why it would have been obvious for someone of ordinary skill in the floor covering art to look for roofing membranes for motivation to modify Haas' carpet panels. The Office Action responds to this argument by asserting that Tajima is reasonably pertinent to the particular problem that application was concerned with, citing *In re Oetiker*, and identifies the problem as the release sheet having a separate central release sheet and being formed with a plurality of strips or three separably removable strips. However, using separate sheets is Applicant's **solution**, not the problem. *In re Oetiker* held that the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. (977 F.2d at 1447). In this case, the Office Action does not make a case that the sources are analogous, but rather asserts that there is a commonality in the solution. "Although the suggestion to combine references may flow from the nature of the problem, '[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" (internal citation omitted) *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000), quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998).

Using Applicant's solution as motivation shows improper hindsight in this case. The problem, as noted in the specification, is how to obtain proper alignment of the strip with respect to the narrow board during installation. This is not a problem faced by Tajima, which is directed to overlapping compound bitumen roofing membranes. Absent proper motivation, a prima facie case of obviousness cannot be made. As such, claims 9-11, 26, 27, 28, and 37-39 are not rendered obvious over Haas in view of Tajima and are patentable.

It is respectfully submitted that the claims are allowable and that the application is in condition for allowance. A prompt notice to that effect is respectfully requested. Should

further issues require resolution prior to allowance, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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